

REMARKS

The Examiner is thanked for the performance of a thorough search.

By this amendment, Claims 22 and 44 have been cancelled. Claims 1, 11, 13, 21, 23, 33, 35, and 43 have been amended. Claims 45-48 have been added. Hence, Claims 1-21, 23-43, and 45-48 are pending in the application.

SUMMARY OF REJECTIONS/OBJECTIONS

The Office Action alleges that the one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120 have not been met.

Claims 22 and 44 were rejected under 35 U.S.C. § 102(a) as allegedly being unpatentable over U.S. Patent Number 5,933,647 issued to Aronberg et al. ("*Aronberg*").

Claims 1-21 and 23-43 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Aronberg* in view of U.S. Patent Number 6,718,358 issued to Bigus et al. ("*Bigus*") in view of U.S. Patent Number 6,446,071 issued to Callaway et al. ("*Callaway*").

The rejections are respectfully traversed.

FILED INFORMATION DISCLOSURE STATEMENTS HAVE NOT BEEN ACKNOWLEDGED

Four Information Disclosure Statements (hereinafter individually referred to as an "IDS") have been filed in the present application, but only one IDS has been acknowledged as having been considered by the Examiner. The Examiner is thanked for the receipt of the initialed 1449 form for the IDS received on March 8, 2004. The Applicants respectfully request (a) consideration of the IDSs received by the Patent and Trademark Office for this patent application on September 22, 2003, June 8, 2004, and August 18, 2004 ("the unacknowledged IDSs"), and (b) receipt of an initialed 1449 form for each of the unacknowledged IDSs to evidence that each has been considered in the present application.

PRIORITY CLAIM AND RELATED APPLICATIONS

The Office Action alleges that the one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120 have not been met because “specific reference to any prior non-provisional application must include the relationship between the applications except when the reference is to a prior application of a CPA assigned the same application number.”

The Applicants note that the only claim of priority made in the present application is to U.S. provisional application serial number 60/231,482, which has been clearly identified in the section entitled “Claim of Priority,” appearing on page 2 of the Applicants’ specification. In contrast with the suggestion made by the Office Action, the present application does not claim priority to any non-provisional patent application. Consequently, it is respectfully submitted the present patent application’s claim of priority is in conformance with 35 U.S.C. § 120.

The Applicants have amended the specification to include reference to the serial numbers of related patent applications in the section entitled “Cross Reference to Related Applications.” The related patent applications are not the subject of a priority claim, but rather contain subject matter related to the present invention. The related applications may contain one or more claims that are substantially similar to one or more claims in the present application. Therefore, the Examiner is encouraged to reference the file history of the related applications, as some of the information contained therein may be material to the examination of the present application.

RESPONSE TO REJECTIONS MADE UNDER 35 U.S.C. §102(a)

Claims 22 and 44 were rejected under 35 U.S.C. § 102(a) as allegedly being unpatentable over *Aronberg*. Claims 22 and 44 have been cancelled herein. Consequently, it is respectfully submitted that the rejection of Claims 22 and 44 made under 35 U.S.C. § 102(a) has been rendered moot.

RESPONSE TO REJECTIONS MADE UNDER 35 U.S.C. §103(a)

Each of the pending claims is patentable over the cited art because each of Claims 1-21, 23-43, and 45-48 recites at least one element that is not disclosed, taught, or suggested by the cited art, even if the cited art had been properly combined.

Amended Claim 1 recites the following features:

A method for automatically installing an application on a device on a network, the method comprising the steps of:

sending, from the device to a server, a request that (a) requests a database application from the server, and (b) includes resource information that indicates resources that are available on the device;

downloading, from the server, an initial customized value for a configuration parameter, wherein the initial customized value was determined by the server based on the resource information;

downloading the database application to the device; and
installing the database application on the device with the initial customized value for the configuration parameter (emphasis added).

The above combination of elements are not disclosed, taught, or suggested, either individually or in combination, by the cited art.

No portion of *Aronberg* discloses, teaches, or suggests the feature of “sending, from the device to a server, a request that (a) requests a database application from the server, and (b) includes resource information that indicates resources that are available on the device” as featured in Claim 1. In the approach of *Aronberg*, no device ever sends a request for an application to a server. At best, *Aronberg* discloses an approach where an agent contacts a server to determine if a condition is satisfied. If the condition is satisfied, the server may cause the application to be installed on the device associated with the agent. Further, to the extent that the device, upon which the agent is installed, transmits any communication to the server, that communication does not contain “resource information that indicates resources that are available on the device.” For example, in *Aronberg*, the only reference to any communication from a device to a server merely states:

“each agent 103, 104 detects a newly scheduled application, and evaluates the condition for distribution to see if the distribution to it is appropriate. If the distribution is appropriate for a particular agent, that agent pulls

down the distribution, i.e., the agent performs the actual distribution” (Col. 4, lines 54-59).

Additionally, in the approach of *Aronberg*, the element of “downloading, from the server, an initial customized value for a configuration parameter, wherein the initial customized value was determined by the server based on the resource information” is not disclosed, taught, or suggested. In *Aronberg*, a profile that comprises a set of instructions to computers 103 and 104 on how to install any application is generated at the workstation running the console 101, but the application is installed on the workstations running the agent 103, 104 (Col. 4, lines 13-26). Thus, to the extent that the profile contains any customized values, the customized values were not “determined by the server based on the resource information” as required by Claim 1.

Neither *Bigus* nor *Callaway* are directed towards installing an application on a device on a network. No portion of *Bigus* or *Callaway* discloses, teaches, or suggests “sending, from the device to a server, a request that (a) requests a database application from the server, and (b) includes resource information that indicates resources that are available on the device” or “downloading, from the server, an initial customized value for a configuration parameter, wherein the initial customized value was determined by the server based on the resource information” as featured in Claim 1.

Consequently, it is respectfully submitted that the above-quoted elements of Claim 1 are not shown, taught, or suggested by the cited art. Since at least one element of Claim 1 is not shown, taught, or suggested by the cited art, it is respectfully submitted that Claim 1 is patentable over the cited art and is in condition for allowance.

Claims 21 features the element of “receiving, at a server from the device, a request that (a) requests said application from a server, and (b) includes resource information that indicates resources that are available on the device.” For reasons similar to those discussed above with respect to Claim 1, it is respectfully submitted that this element is not disclosed, taught, or suggest, either individually or in combination, by the cited art. Consequently, it is respectfully submitted that Claim 21 is patentable over the cited art and is in condition for allowance.

Claims 2-20 and 47 are dependent claims, each of which depends (directly or indirectly) on Claim 1 or Claim 21. Each of Claims 2-20 is therefore allowable for the

reasons given above for the claim on which it depends. In addition, each of Claims 2-20 introduces one or more additional limitations that independently render it patentable. However, due to the fundamental differences already identified, to expedite the positive resolution of this case a separate discussion of those limitations is not included at this time, although the Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

Claims 23-43 and 48 each recite limitations similar to those discussed above with respect to Claims 1-21 and 47. For example, each of new Claims 23-43 and 48 are computer readable medium claims that correspond to previously discussed method Claims 1-21 and 47. Consequently, it is respectfully submitted that Claims 23-43 and 48 are patentable for at least the reasons discussed above with respect to Claims 1-21 and 47.

NEW CLAIMS 45 AND 46

New Claims 45 and 46 are fully supported by the Applicants' disclosure, generally from page 6, line 1 to page 121, line 8, and more specifically in page 94, line 1 to page 95, line 3.

New Claims 45 and 46 each feature the following elements:

“receiving, at an appliance, a document that includes elements that specify
(a) steps for installing an application on the appliance, and (b)
customized parameter values to use when installing the application
on the application; and
automatically translating the elements to commands, which are executed
by the appliance to perform said steps to install the application on
the application using the customized parameter values”

The above-quoted combination of elements are not disclosed, taught, or suggested by the cited art.

The approach of *Aronberg* and the features of Claims 45 and 46 are directed towards different approaches for installing an application on a device. The approach of *Aronberg* may be used to transmit a profile to a device. The profile “is a set of instructions to the computers 103 and 104 on how to install any application” (Col 4, lines 25-26). Computers 103 and 104 directly execute the commands of the profile to install the application. As computers 103 and 104 may directly execute the commands specified in the profile, computers 103 and 104 do not perform any act of translating elements of

the profile to commands, as the profile already contains the commands, which when executed, cause computers 103 and 104 to install the application.

In sharp contrast to the features of Claims 45 and 46, there is no suggestion in the approach of *Aronberg* of “receiving, at an appliance, a document that includes elements that specify (a) steps for installing an application on the appliance, and (b) customized parameter values to use when installing the application on the application “ and “automatically translating the elements to commands, which are executed by the appliance to perform said steps to install the application on the application using the customized parameter values.”

Consequently, it is respectfully submitted that New Claims 45 and 46 are patentable over the cited art, and are each in condition for allowance.

CONCLUSION

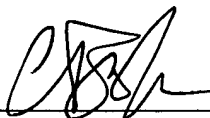
For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any fee shortages or credit any overages Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP



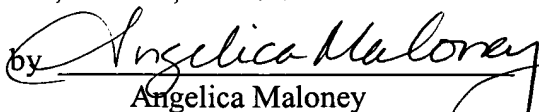
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Mail Stop Amendment**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

on November 11, 2004

by 
Angelica Maloney